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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,315	10/22/2001	Kazuhiko Hachiya	112857-253	7385
29175	7590	07/27/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC			BLACKWELL, JAMES H	
P. O. BOX 1135				
CHICAGO, IL 60690-1135			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/039,315	HACHIYA ET AL.
	Examiner James H. Blackwell	Art Unit 2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 31 March 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-71 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-71 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10/22/01, 3/31/05 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/15/02, 10/19/04, 3/31/05</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This Office Action is responsive to communications: amendment filed **03/31/2005**, to the original application filed **10/22/2001**.
2. Corrections by Applicant to objections applied to Figure 1 has been made. The Examiner withdraws the objection. However, corrections to Figure 56 have not been made.
3. Objections to Claims 58-62 because Claim 58 depended from a method claim, claim 39, instead of an apparatus claim have been corrected by Applicant. Objections have been withdrawn.
4. Objection to the disclosure because of an embedded hyperlink has been withdrawn per Applicant's arguments.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 5-7, 10-15, 18-20, 23-26, 29-32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (hereinafter Cook, U.S. Patent No. 5,727,950), in view of Hussey (U.S. Patent No. 5,826,269).

**In regard to independent Claim 1, Cook discloses that an agent is displayed on a screen (319 in Fig. 3) and the behavior of the agent is managed by agent parameters (Col. 35, lines 58-67).**

Cook also teaches that the agent interface can be implemented using E-mail (group communications discussed in Col. 40, lines 9-18; Col. 46, lines 6-7).

Cook does not specifically disclose that agent parameters ... are annexed to the main text of the E-mail.

However, Hussey discloses a system in which the main text of an E-mail message from a user is used to submit queries to a database (Col. 4, lines 11-16). In this system, an email containing an SQL command is sent to the server, the server interprets the SQL command and passes it to the database for processing. The database, in turn, sends the results back to the user at a later time via email.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have added the parameters for controlling the agent to the main text of the E-mail, since Cook suggested that the group communications (E-mail) could be used for the agent interface, and Hussey taught that the main text of E-mail could be used for passing control parameters.

**In regard to dependent Claims 2 and 5,** regarding sending sole and plural E-mail messages, it was notoriously well known at the time of the invention that commercially available E-mail programs allow the user to send a single message to a single recipient; and also to send multiple messages to multiple recipients. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have included the ability to send a single message to a single recipient, since it was included in the ubiquitous commercial E-mail programs available at that time, and since Cook suggested that group communications (E-mail) could be used for the agent interface.

**In regard to dependent Claims 6-7 and 10,** Claims 6-7, and 10 are drawn to an apparatus to perform substantially the same steps as in the method of Claims 1-2, and 5, and are rejected similarly.

**In regard to independent Claim 11,** it was notoriously well known at the time of the invention that commercially available E-mail programs allow the user to both send and receive messages; otherwise the programs would be useless since this form of communication inherently involves a sender and a receiver (although these can be one and the same entity).

**In regard to independent Claim 12,** Claim 12 is drawn to an apparatus to perform substantially the same steps as in the method of Claim 11, and is rejected similarly.

**In regard to dependent Claim 13,** Cook teaches that communications between the agent and the materials controlling it are bi-directional; the parameters are sent to the agents, and the agent set global parameters and return messages confirming actions proposed by the controlling materials (Col. 51, lines 1-5).

**In regard to independent Claim 14,** the recited limitations are substantially a combination of those found in Claim 1 and 11, and are rejected similarly.

**In regard to dependent Claims 15 and 18,** the recited limitations are substantially the same as those of Claims 2 and 5, and are rejected similarly.

**In regard to independent Claim 19, and dependent Claims 20, and 23,** Claim 19, and Claims 20, and 23 are drawn to an apparatus to perform substantially the same steps as in the method of Claims 14-18, and are rejected similarly.

**In regard to dependent Claim 24,** the added limitation is substantially the same as that found in Claim 13, and is rejected similarly.

**In regard to independent Claim 25, and dependent Claims 26, and 29,** Claim 25, and Claims 26, and 29 are drawn to “program supplying medium” (article of manufacture) that performs substantially the same steps as in the method of Claims 1-2, and 5 and are rejected similarly.

**In regard to independent Claim 30,** Claim 30 is drawn to a “program supplying medium” (article of manufacture) that performs substantially the same steps as in Claim 11, and is rejected similarly.

**In regard to independent Claim 31, and dependent Claims 32, and 35,** Claim 31, and Claims 32, and 35 are drawn to “program supplying medium” (article of manufacture) that performs substantially the same steps as in the method of Claim 14-15 and 18, and is rejected similarly.

7. Claims 36-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Linnett (U.S. Patent No. 5,682,469).

Refer to the rationale relied upon in the rejection of Claims 1-2, 5-7, 10-15, 18-20, 23-26, 29-32, and 35.

Furthermore, with respect to **independent Claims 36 and 54, and dependent Claims 37-53 and 55-71**, it is noted that Cook fails to teach *continuously updating said plurality of agent parameters*. However, refer to Linnett's columns 3-13, in which he discloses that the behavior of the personal character continuously changes in response to what the user needs.

Linnett also teaches the animation, automatic updating, etc. It would have been obvious to one of ordinary skill in the art at the time of invention to combine Linnett's teachings with Cook because the animated agent of Linnett would be useful to helping an e-mail recipient to understand applications sent by e-mail.

***Response to Arguments***

8. The Examiner acknowledges corrections made to overcome objections to claims 58-62, and the drawings Figs. 1 and 56. Examiner also acknowledges error made in embedded hyperlinks in the Specification and has withdrawn rejection.

The Examiner also acknowledges corrections made to Claims 3-4, 8-9, 16-17, 21-22, 27-28 and 33-34 that were made under 35 U.S.C. 101 as allegedly claiming the same invention as that of claims 1-12 of prior U.S. Patent No. 6,311,195. The Examiner agrees to the arguments made by the Applicant and withdraws 35 U.S.C. 101 rejections.

The Examiner further acknowledges that Claims 1-2, 6-7, 14-15, 19-20, 25-26 and 31-32 that were rejected under the judicially created doctrine of obviousness-type double patenting as being anticipated by claims 1, 3, 5, 7, 9 and 11 of the '195 patent above have been overcome by the submission of a Terminal Disclaimer to overcome these rejections over the '195 patent.

Rejection of Claims 1-2, 5-7, 10-15, 18-20, 23-26, 29-32 and 35 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,727,950 to Cook et al. ("Cook"), in view of U.S. Patent No. 6,003,070 to Frantz ("Frantz"), have been withdrawn due to the improper prior art of Franz.

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However, the Examiner makes new rejection of Claims 1-2, 5-7, 10-15, 18-20, 23-26, 29-32, and 35 under rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (hereinafter Cook, U.S. Patent No. 5,727,950), in view of Hussey (U.S. Patent No. 5,826,269).

In addition, the Examiner rejects Claims 36-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Linnett (U.S. Patent No. 5,682,469).

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
06/27/05

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